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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/172,853	10/15/1998	CHRISTINE DUPUIS	5725.0134-01	9863

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EXAMINER

WEBMAN, EDWARD J

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 04/01/2003

32

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/17253

Applicant(s)

DUPUIS

Examiner

WEBMAN

Group Art Unit

1617

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 2/3/03.
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 25-67 is/are pending in the application.
- Of the above claim(s) 25-62, 63 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 43-62, 64-67 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 31
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43-62, 64-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sramek in view of EPA 590604 (EP '604) and chem. Abstract 117546 ('546).

Sramek teaches an aerosol composition containing hair-setting resins (abstract). Hair setting resins which are acrylic polymers containing such monomers as methacrylic acid, hydroxymonoesters of methacrylic acid with C2 glycol, methyl methacrylate, and butyl acrylate are specified (column 5 lines 59-65). Sramek also teaches alcohol and water (col.5 lines 54-65). Generally less than 10% water is disclosed (column 5 line 68-column 6 line 1). Water-soluble cosmetically acceptable basic compounds, including AMP (column 9 lines 22-34), perfumes, protein hydrolysates, preservatives, and silicones (column 9, lines 47-56), the last disclosed by applicant as a conditioning agent on page30-second paragraph, are specified.

Applicants stipulate that EP '604 teaches the claimed "acrylates" copolymer (page 7 first two paragraphs), '604 teaches freeze-thaw stability in hair sprays (abstract). 2-20% water is specified (page 5 lines 20-27). The copolymer provides excellent performance characteristics, including feel and shine (page 2 lines 35-37).

'546 teaches a hair setting polymer comprising C2-8 alkyl acrylates, methylmethacrylate, hydroxyethyl-methacrylate and methacrylic acid. High effectiveness and water resistance are disclosed.

It would have been obvious to one of ordinary skill to add the polymer of '604 to the composition of Sramek to impart freeze-thaw resistance and to use the polymer of '546 as a hair setting polymer in view of its high effectiveness and water resistance. As to the claimed 41% aqueous dispersion of the hydroxyacrylate, applicants disclose such is an item of commerce (example 6, page 39).

Applicants now argue that neither reference teaches plural hair-setting resins. However, it is well settled law that one of ordinary skill would add an additional compound to a composition containing a like compound for the additional beneficial effect of the added compound. *In re Kerkhoven* 205 USPQ 1069 (CCPA 1980). Here, both Sramek and '546 teach hair setting polymers.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 43-62, 64-67 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10, 12, 18-19 of copending Application No. 09/364,561. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims

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encompass those of '561 concerning percent monomers where as '561 encompasses the instant claims regarding the particular monomers and the fixing or conditioning polymer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Webman whose telephone number is 308-4432. The examiner can normally be reached on Monday-Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Padmanabhan can be reached on 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1234.

Webman/tgd
March 11, 2003


EDWARD J. WEBMAN
EXAMINER
GROUP 1700